

## **REMARKS/ARGUMENTS**

Claims 1-20 are pending in the present application. No claims were canceled; claims 19 and 20 were amended; and no claims were added. Reconsideration of the claims is respectfully requested.

### **I. 35 U.S.C. § 101**

The Office Action has rejected claims 19 and 20 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. This rejection is respectfully traversed.

Regarding claim 19 and 20, the Office Action states:

Claims 19 and 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a computer program code. Computer program code, per se, is not considered patent eligible subject matter under the current guidelines of 35 U.S.C. 101. In order for claims 19 and 20 to be considered patent eligible subject matter, the computer program must be tangibly embodied on a computer readable medium and executable on a computer to perform the method steps. Claims 19 and 20, as recited, are not tangibly embodied on a computer readable medium and executable on a computer to perform the method steps.

Office Action dated August 30, 2007, p. 3.

In response, Applicants have amended claims 19 and 20 to recite “executable on a computer.”

### **II. 35 U.S.C. § 102, Anticipation**

The Office Action has rejected claims 1-19 under 35 U.S.C. § 102 as being anticipated by *Silver*, System and Method for Managing Restaurant Customer Data Elements, U.S. Publication No. 2005/0043996, February 24, 2005 (hereinafter “*Silver*”). This rejection is respectfully traversed.

Regarding claim 1, the Office Action states:

#### **As per claim 1**

#### **Silver teaches:**

- Presenting a set of items for a bill for which payment is required (see at least page 4, paragraph 47)
- Receiving user input identifying items from the set of items for payment by a particular person to form identified items (see at least pages 4-5, paragraphs 56-59)
- Processing payment for the identified items (see at least pages 4-5, paragraphs 56-59)
- Repeating the receiving and processing steps until all items in the set of items have been identified for payment (see at least pages 4-5, paragraphs 56-59)

Office Action dated August 30, 2007, p. 4 (emphasis in original).

In response, Applicants have provided the attached Declaration under rule 1.131 and related documents, which shows that Applicants' invention pre-dates the *Silver* reference. Thus, Applicants submit that the *Silver* reference is not valid as prior art under 35 U.S.C. § 102(e).

Therefore, the rejection of claims 1-20 under 35 U.S.C. § 102 has been overcome.

### **III. Conclusion**

It is respectfully urged that the subject application is patentable over *Silver* and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: November 30, 2007

Respectfully submitted,

/Gerald H. Glanzman/ 

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: <b>Dobson et al.</b>	§ Confirmation No.: <b>2685</b>
Serial No.: <b>10/713,730</b>	§
	§ Group Art Unit: <b>3691</b>
	§
Filed: <b>November 13, 2003</b>	§ Examiner: <b>Hammond III, Thomas M.</b>
	§
For: <b>Method and Apparatus for Allocating Items on a Bill</b>	§ Attorney Docket No.: <b>AUS920030331US1</b>

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**35525**  
PATENT TRADEMARK OFFICE  
CUSTOMER NUMBER

**DECLARATION UNDER RULE 1.131**

Sir:

I, Jeffrey S. LaBaw, a registered patent attorney, declare as follows:

1. I was the attorney handling the above-identified patent application at the time of filing.
2. I was an employee of International Business Machines Corporation, Inc. at the time the invention was conceived and constructively reduced to practice. I remain an IBM employee.
3. The invention as claimed in the above-identified application was constructively reduced to practice in the form of a formal Application, which is attached hereto, which I received from outside counsel, on or before August 17, 2003. In addition, a copy of an e-mail from outside counsel with redacted date is attached hereto.
4. I exercised due diligence in pursuing filing of said Application from August 17, 2003 until filing the Application on November 13, 2003. Matthew Dodson was not an employee of the IBM Corporation, and negotiations were needed to gain permission from his employer for Matthew to assign the invention to IBM.

The declarant further states that the above statements were made with knowledge that willful false statements and the like are punishable by fine and/or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that any such willful false statement may jeopardize the validity of this application or any patent resulting therefrom.

DATE:

11/29/07

  
Jeffrey S. LaBaw